

## REMARKS

### I. Status of the Claims

Claims 1-105 were filed with the application. Claims 18-23, 35-60, and 71-105 have been canceled. Thus, claims 1-17, 24-34, and 61-69 are under consideration, have been examined, and stand rejected under 35 U.S.C. §112, second paragraph, 35 U.S.C. §101, and 35 U.S.C. §102(b). The specific grounds for rejection of these claims, and applicants' response thereto, are set out in detail below.

### II. Rejections Under 35 U.S.C. §112, Second Paragraph

The examiner has rejected claims 1-17 under §112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. In response to the examiner's rejection, applicants have amended the claims to recite "STARS" rather than "STAR" and to elaborate on the use of acronyms for promoters. Further, claim 17 has been amended to recite the upper length of 1146 as suggested by the examiner.

The examiner has also asserted that applicants have not properly defined "stringency" in the specification so that the word "complement thereof" as used in claim 7 and its dependent claims is indefinite. Applicants traverse. The specification provides a discussion of hybridization and stringency conditions at page 23 of the specification. Thus, the term complement is not indefinite.

Therefore, it is believed the claims are fully in compliance with §112, second paragraph, and it is respectfully requested that the claims be reconsidered and the rejections withdrawn.

### **III. Rejections Under 35 U.S.C. §101**

The examiner has rejected claims 7-14 under §101 alleging the claims are directed to non-statutory subject matter. The phrase “isolated and purified” has been inserted in the preamble of claim 7 and as such applicants believe the examiner’s concerns have been addressed. Reconsideration and withdrawal of the rejection is therefore respectfully requested.

### **IV. Rejections Under 35 U.S.C. §102(b)**

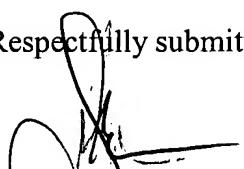
The examiner has rejected claims 1-6, 24-34, and 61-69 under §102(b), as being anticipated by Arai *et al.* Arai *et al.*, published in July of 2002, and the correct priority date for this application, based on the provisional application 60/404,706, is August of 2002, less than one year from the date of publication of Arai *et al.* Therefore, Arai *et al.*, is a §102(a) reference for prior art purposes, not §102(b) as alleged. As discussed in the attached “Katz” declaration under 37 C.F.R. §1.132, the non-inventor author of Arai *et al.* (Spencer) was acting under the direction of inventors Arai and Olson and did not make any conceptual contribution to the subject matter described therein.

Thus, Arai *et al.* is not “by another,” and hence cannot be prior art under 35 U.S.C. §102(a). Reconsideration and withdrawal of the rejection is therefore respectfully requested.

V. Conclusion

In light of the foregoing, applicants respectfully submit that claims 1-17, 24-34, and 61-69 are in condition for allowance, and an early notification to this effect is earnestly solicited. Should the examiner have any questions regarding this response, a telephone call to the undersigned attorney at (512) 536-3184 is invited.

Respectfully submitted,

  
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Date: August 3, 2004